

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of

Applicant : Goebel
Serial No. : 10/780,488
Filed : February 17, 2004
Title : FUEL CELL SHUTDOWN AND STARTUP USING A CATHODE
RECYCLE LOOP
Docket No. : GP-304183/GMC 0046 IA
Examiner : Yuan
Art Unit : 1745

Commissioner for Patents
PO Box 1450
Alexandria, Virginia 22313-1450

EFS Web Electronic Submission
May 3, 2007

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

In the Office Action mailed April 23, 2007, the Examiner made a restriction between Group I, corresponding to claims 1 through 10, drawn to a method of shutting down an operating fuel cell system, Group II, corresponding to claims 11 through 14, drawn to a method of starting a fuel cell system, Group III, corresponding to claims 15 through 17, drawn to a device with at least one fuel cell, and Group IV, corresponding to claims 18 through 27, drawn to a method of transiently operating a fuel cell system. In response, the Applicant elects for prosecution the invention of Group IV. This election is with traverse.

The Applicant notes that 35 U.S.C. 121 provides for restriction only if two or more independent and distinct inventions are claimed in one application. While Section 802.01 of the MPEP indicates that a restriction between independent or distinct inventions is permissible, such section of the MPEP is clearly erroneous in view of the plain and unambiguous language of 35 U.S.C 121. A review of the Office Action reveals that the Examiner has failed to clearly indicate how the subject matter recited in the two groups of claims represents both independent and distinct inventions as required by 35 U.S.C 121. In this connection, the above noted section of

Serial No.: 10/780,488
Art Unit: 1745

the MPEP defines the term "independent" as meaning there is no disclosed relationship between the two or more disclosed inventions. In other words, to be independent, the inventions must be unconnected in design, operation or effect. By way of example, a process of use and a product incapable of being used in practicing the process would be considered independent. By contrast, a method of shutting down a fuel system and a method of starting up such a system, as well as a method of transiently operating such a system, would NOT be considered independent.

Moreover, the Office Action states that restriction is required between the product and the process, despite both being classified in the same class (429), and that in at least twenty one occasions (four as a primary examiner and seventeen as an assistant examiner), the Examiner has examined applications and subsequently issued patents where both subclasses (13 and 34) identified in the restriction have been included together. Assuming *arguendo* that even if such devices and methods were determined to be distinct, such is not enough in and of itself to make a restriction proper. An overarching concern, clearly set forth in MPEP 803, is that absent such a restriction, there would be a "serious burden" on the Examiner. Contrarily, if a search and an examination of an entire application can be made without serious burden, the Examiner must examine the application on the merits even though the application includes claims to distinct or independent inventions. Based on the Examiner's classification of all of the four groups identified in the restriction as fitting into either class 429, subclass 13 or class 429, subclass 34, and considering that the Examiner appears to be well-versed in searching both of the aforementioned subclasses of the same class together in numerous previous applications, it would appear that a complete and thorough examination of the subject matter recited in the present claims would require a search at least in the areas designated by the Examiner in the Office Action. As such, no serious burden on the Examiner is present, and the Examiner should be required to examine all of the claims of the present application.

Nevertheless, in order to comply with the Examiner's requirement, the Applicant provisionally elects, with the aforementioned traverse, claims 18 through 27, all of which are

Serial No.: 10/780,488
Art Unit: 1745

drawn to a method of transiently operating a fuel cell system.

Please contact the undersigned to resolve any matters related to this response or any other aspect of the present application.

Respectfully submitted,

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